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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,714	07/18/2003	Tomio Hirano	240464US6	1566
22850	7590	02/22/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			CHEVALIER, ALICIA ANN	
			ART UNIT	PAPER NUMBER

1772

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,714

Applicant(s)

HIRANO ET AL.

Examiner

Alicia Chevalier

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/1/05 and 8/18/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

RESPONSE TO AMENDMENT

1. Claims 1-7 and 18 are pending in the application, claims 8-17 have been cancelled.
2. Amendments to claims, filed on August 18, 2005, have been entered in the above-identified application.

WITHDRAWN REJECTIONS

3. The 35 U.S.C. §112, §102 and §103 rejections, made of record in the office action mailed April 19, 2005, have been withdrawn due to Applicant's amendment in the response filed August 18, 2005.

NEW REJECTIONS

4. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Claim Rejections - 35 USC § 103

5. Claims 1, 3-7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan (U.S. Patent No. 4,781,792) in view of Yoneda et al. (U.S. Patent No. 5,314,731).

Regarding Applicant's claim 1, Hogan discloses a glass for an automobile (*col. 5, lines 5-7*) comprising a glass substrate (*title*) having a cut side (*etching side, col. 7, lines 11-32*), and a depth of a mark on the cut side face is 0.06 mm or more (*col. 7, lines 32-33*).

The preamble “for a touch panel” is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a *structural difference* between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02.

The limitation “at least partially formed by cutting with laser light radiation” is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

Hogan fails to disclose that the surface roughness of the cut side face of the glass substrate is 50 nm or less.

Yoneda discloses window glass for automobiles (*col. 1, lines 14-19*). Yoneda teaches that substantial scorching or a fine roughness, i.e. high surface roughness, on the surface of a glass lowers its basic function and scatters light on its surface making it difficult to secure the field of view, and consequently there will be a problem in securing safety (*col. 1, lines 46-52*).

Hogan and Yoneda are analogous because both disclose glass for windows in automobiles.

The exact surface roughness of the glass is deemed to be a result effective variable with regard to the scattering of light. It would require routine experimentation to determine the optimum value of a result effective variable, such as surface roughness, in the absence of a

Art Unit: 1772

showing of criticality in the claimed surface roughness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill in the art would have been motivated by disclosure of Yoneda to minimize the surface roughness in order to avoid substantial scattering of light. One would have been motivated to minimize the surface roughness because it would allow better field of view and thus secure safety.

Regarding Applicant's claim 3, Hogan discloses that the glass substrate has no crack and pulverized powder at the cut side face, since the reference is silent about cracks and pulverized powder.

Regarding Applicant's claim 4, Hogan discloses that the depths of the mark and another mark on a second cut side face of the glass substrate are different, the second cut face being different from the first cut side face (*figure 5*).

Regarding Applicant's claims 5 and 7, Hogan fails to disclose that the difference in depths of the laser marks is different by 2% or more between on the first cut side face and on the second cut side face or the thickness of the glass substrate is 0.25 mm or more and 0.7 mm or less. Note: The Examiner has constructed "0.25 mm or more and 0.7 mm or less" to mean equal to or greater than 0.25 mm and less than or equal to 0.7 mm.

It would have been an obvious matter of design choice to change the thickness or depth of glass or marks, since a modification would have involved a mere change in size of the glass or marks. A change in size or shape is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. MPEP 2144.04 (I) and (IV).

Regarding Applicant's claim 6, the mark formed on the cut side face of the glass substrate is deemed to have a predetermined depth from a first principle surface, and another

Art Unit: 1772

laser mark is formed on a second cut side face of the glass substrate and deemed to have a predetermined depth from a second principal surface, the second side face being different from the first cut side face and the second principal surface is a back surface of the first principal surface (*figure 5*).

Regarding Applicant's claim 18, Hogan discloses that the cut side is an outer peripheral edge of the glass substrate (*figure*).

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan in view of Yoneda as applied above, and further in view of Chiba et al. (U.S. Patent No. 6,287,996).

Hogan and Yoneda are relied upon as described above.

Hogan and Yoneda fail to disclose that the glass substrate has a strength of 45 kgf or more and 90 kgf or less on a static load test.

Chiba discloses a glass comprising a glass substrate with a strength of 45 kgf or more and 90 kgf or less based on a static load test (*col. 11, lines 13-18*), which does not deteriorate (*col. 2, lines 40-45*).

Hogan, Yoneda and Chiba are analogous because they all disclose glass for windows in automobiles.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have a glass with a strength of 45 kgf or more and 90 kgf or less based on a static load test in the Hogan and Yoneda as taught by Chiba in order to insure the strength will not deteriorate.

ANSWERS TO APPLICANT'S ARGUMENTS

7. Applicant's arguments in the responses filed December 1, 2005 and August 18, 2005 regarding the previous rejections of record have been considered but are moot since the rejections have been withdrawn.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

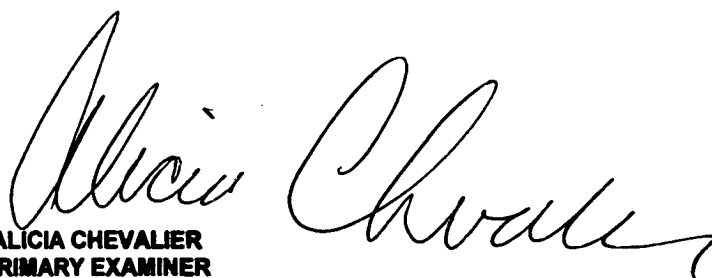
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:00 pm.

Art Unit: 1772

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ac
2/21/06


ALICIA CHEVALIER
PRIMARY EXAMINER